

### **REMARKS/ARGUMENTS**

This Amendment is in response to the Office Action of January 21, 2009, in which the Examiner (1) rejected claims 24, 25 and 28 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter, (2) objected to claims 24, 25 and 28 on the basis of the inconsistent terminology, (3) rejected claims 2-8, 11-12, 14-19, 22 and 24-30 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention, and (4) rejected claims 2-8, 11-12, 14-19, 22 and 24-30 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0082962 to Farris (“**Farris**”) and, for claims 24 and 2-8, in view of Official Notice as documented by U.S. Patent No. 6,173,272 issued to Thomas (“**Thomas**”), U.S. Patent No. 6,181,837 issued to Cahill (“**Cahill**”) and U.S. Patent Application Publication No. 2002/0194125 issued to Shimada (“**Shimada**”). In connection with the rejection under 35 U.S.C. §103, the Examiner found that there was not proper support in the two applications having filing dates to which the present Application claims benefit, namely, U.S. Patent Application No. 09/613,615 (hereinafter “**‘615 Application**”) filed on July 11, 2000 and U.S. Patent Application No. 09/476,384 (hereinafter “**‘384 Application**”) filed December 30, 1999.

By the present Amendment, independent claims 24, 25 and 28 and dependent claims 2 and 5-8 have been amended, and new claims 31 and 32 have been added. New claims 31 and 32 now recite the “money order” and “residence address” features previously recited in (and now omitted from) claim 24. Dependent claims 2 and 5-8 have been amended for consistency with independent claim 24.

#### **Rejection Under 35 U.S.C. §101**

Applicants respectfully traverse the newly made rejection under 35 U.S.C. §101.

The Examiner states that this rejection is made on the basis that the recited invention is not sufficiently tied to a particular apparatus and is interpreted as merely a process with a series of steps or acts taken by human operators. Applicant notes that the claims as previously presented do recite particular apparatus (on-line system, payor computer and a payee computer). Also, the payment enabler is defined as being part of the on-line system.

However, in order to advance prosecution, Applicants now recite in claims 24, 25 and 28 that the on-line system is an “on-line *computer* system,” and that the payment enabler has a “computer processor” as part of performing the various method steps. Such additional features are supported in the present Application (see, e.g., page 6 of the Specification), as well supported in the applications from which priority is claimed (see, e.g., page 3 of the ‘615 Application, and page 12 of the ‘384 Application).

### **Claim Objections**

In order to overcome the claim objections, claims 24 and 28 have been amended to recite that the bank handler is a “bank funds transfer handler,” as suggested by the Examiner. Since the term “bank handler” does not appear in claim 25, such claim was not similarly amended.

### **Rejection Under 35 U.S.C. §112**

The Examiner has rejected the claims under 35 U.S.C. §112 because the terms “handler” and “payment enabler” are indefinite.

Inasmuch as Applicants have defined the payment enabler as having a “computer processor,” this rejection as it pertains to the payment enabler is now believed overcome.

As to the handlers, Applicants have not amended the claims. The Examiner refers to possible “conflicting meanings/interpretations” and asks whether the handlers are “a structural means,” a particular person,” or “something else.” The various handlers are both generally and specifically described the Specification. For example, page 4 describes the handlers as:

“typically organizations that are used to pay for items or to store money, but often are difficult for the payor or payee 110, 130 to use when making payments.

Examples of money handlers 160 include credit/debit cards, banks, promotion programs, and agent locations 125. In this embodiment, the agent location 125 serves as an interface to the payment enabler 170 as well as a money handler 160. Handlers 160 have established mechanisms for moving money that payors 110

and payees 130 are accustomed to using, such as, paying for items with a credit card and withdrawing money from a bank.”

Further, pages 4, 5 and 6 describe examples of five different handlers 160-through 160-5, and the various interfaces (180-1 through 180-5) that are used in conjunction with the handlers. Further, an agent location 125 that corresponds to the agent handler 160-5 is described in detail in conjunction with Fig. 4.

Applicants respectfully submit the claims do meet the definiteness requirement under 35 U.S.C. §112. A claim rejected for indefiniteness must not be analyzed in a vacuum, but rather must be considered in light of (1) the content of the patent application and disclosure; (2) the interpretation that would be given to one of ordinary skill the art, and (3) the teaching of the prior art. MPEP §2173.02. Applicants do not believe a prima facie case of indefiniteness has been established, given the detailed descriptions of “handlers” in the Specification and given that Applicants are unable to find the “conflicting meanings/interpretations” referred to by the Examiner. Thus, Applicants do not believe further amendments to the claims are required to overcome the rejection under 35 U.S.C. §112.

### **Rejection Under 35 U.S.C. §103**

Applicants continue to believe that the claims are not taught or suggested by the cited references, and in particular **Farris**, for the reasons given in the prior Response dated November 12, 2008. However, even if **Farris** were deemed to directly or inherently teach the specific features cited by the Examiner, and even if **Farris** were deemed to be an enabling disclosure, Applicants again respectfully submit that **Farris** is not a proper reference because the present Application is entitled to the benefit of priority dates in both the ‘615 and ‘384 Applications that are prior to the earliest priority date claimed in **Farris** (July 27, 2000), for the reasons stated in the prior Response.

The Examiner appears to believe (page 25 of the Office Action) that there is not sufficient support found in the prior ‘384 and ‘615 Applications in order for the present Application to claim priority, because (1) Applicants admit the ‘384 Application does not disclose the feature of the “payment enabler converting the credit amount from the first value to

a second value,” and (2) the ‘615 Application does not disclose “the payment enabler receiving payout instructions” having the features specified in the claims .

As to the ‘384 Application, Applicants apologize for not specifically citing (on page 12 of the prior Response) the specific reference to the ‘384 Application where the “payment enabler converting” feature can be found. However, the unintentional omission of a specific reference was not intended to be an “admission” that the feature was not disclosed. In fact, such feature can be found at pages 9, 10, 39, 43, 48 and 49 (referring to the handling or service fees giving rise to different values received by and paid to the payor and payee using the intermediary’s payment enabler 240). The Examiner will note that service fees are also described in conjunction with the payment conversion function 328 in the present Application (e.g., page 7 of the Specification).

Since this feature is disclosed in the ‘384 Application (and was the only feature identified by the Examiner as not supported by the ‘384 Application), the ‘384 Application does fully support the present Application having a priority date based on the filing date of the ‘384 Application (December 30, 1999).

In addition, Applicants point out that the ‘615 Application incorporates by reference the entire disclosure of the ‘384 Application (see page 7 of the ‘615 Application), and thus for this reason alone, the ‘615 Application also fully supports the present Application having a priority date based on the filing date of the ‘615 Application (July 11, 2000).

Furthermore, the Applicants respectfully submit the feature of “the payment enabler receiving payout instructions” can be found in the ‘615 Application. While unnecessary to specifically find a description in the ‘615 Application since such feature is in the fully incorporated ‘384 Application, Applicants point to, among other places, pages 8, 9, 14, 17 and 18 of the ‘615 Application that refer to the payment enabler being provided transaction details pertaining to the name and an email address identifier of the payee, the amount to be credited (transferred), and sending (to a location of the payee) a paper check.

Accordingly, given that the claims are supported by both the ‘384 Application and the ‘615 Application, the present Application is entitled to a priority date of December 30, 1999, and thus **Farris** is not a proper reference and the claims are allowable thereover.

The other references (**Thomas, Cahill** and **Shimada**) were cited by the Examiner for purposes of documenting Official Notice of the payee having an address used as a delivery location. Applicants have reviewed such references, and do not believe they fully disclose such delivery location feature (at least in the context in which such feature is used in Applicants' invention). However, since such references clearly do not show features of the claims for which the Examiner was relying on **Farris**, all the claims are likewise clearly allowable over **Thomas, Cahill** and **Shimada**.

### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. Applicants do not acquiesce to any objection, rejection, or argument not specifically addressed herein. Rather, the Applicants believe the amendments and arguments contained herein overcome all objections, rejections, or arguments.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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